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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,698	01/27/2002	Jeffrey L. Huckins	ITL.0699US	4036

21906 7590 10/19/2006

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EXAMINER

KIM, HAROLD J

ART UNIT PAPER NUMBER

2181

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,698

Applicant(s)

HUCKINS, JEFFREY L.

Examiner

Harold Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

FRITZ FLEMING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100
20/16/2006

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the filing of the Amendment, on 7/24/2006, has been considered but they are not persuasive. Accordingly, this action is made **FINAL**.

2. Claims 1-27 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 recites "said component external" in the second line of the claim. There are insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 8, 9, 11-15, 18, 19, and 21, 23-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Hwong et al., US Patent no. 6,457,055.

5. In re claim 1, Hwong et al. shows a method comprising:

providing a first bus technology on a system [IEEE 802.3 Ethernet, col 2, line 39; older 10Mbps];

dividing responsibility for a second bus technology [Fast Ethernet, col1, line 19; col 3, line 9], different from said first bus technology, between a controller integrated on said system [local device 100, fig 1; col 5, line 24] and an external component [link partner device, 106, fig 1; col 5, line 25; 1112, fig 10];

determining whether the external component is coupled to said system [1112, fig 10];

if said external component is not coupled to said system, indicating that said second bus technology is not available and that said controller is non-functional [1114, fig 10; 906, 908 in fig 9, save the configuration so that the controller is only functional to the specified ability instead of all supported ability in device configuration, in other words, the controller is non-functional to the technology that the connection is failed as shown in 1114, fig 10];

when said external component is coupled to said system, indicating that said second bus technology is available and linking said controller to said external component to implement said second bus technology [1116, 110, 1118, fig 10].

6. In re claim 2, Hwong et al. shows accessing said external component through a bus [fiber and twisted-pair cables, col 1, lines 18-19].

7. In re claim 3, Hwong et al. shows accessing a configuration space includes accessing a configuration space on a controller [fig3; col 7, lines 24-39].

8. In re claim 4, Hwong et al. shows detecting a component external [1112, fig 10; fig 3] to said system from said controller [col 7, lines 24-39].

9. In re claim 5, Hwong et al. shows accessing a configuration space on said component external to said system [col 7, lines 24-39].

10. In re claim 8, Hwong et al. shows implementing a capability requiring two functions, one of said functions implemented by said platform integrated component and the other of said functions implemented by said component external said system [col. 7, lines 49-55].

11. In re claim 9, Hwong et al. shows writing information includes writing information necessary for the platform integrated component communicate with said component external to said system [col 7, lines 18-27].

12. Claims 11-15, 18, and 19 are rejected under the same rationale as discussed above in claims 1-5, 8, and 9.

13. In re claim 21, Hwong et al. shows a system [figs 11-14] comprising:

a processor [1108, fig 12];

a bus [1112, fig 12] coupled to said processor, said bus capable of using a first [IEEE 802.3 Ethernet, col 2, line 39; older 10Mbps] and a second bus technology [Fast

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Ethernet, col 1, line 19; col 3, line 9], said first bus technology being different than said second bus technology; and

a controller [local device 100, fig 1; col 5, line 24] to determine whether an external component [link partner device, 106, fig 1; col 5, line 25; 1112, fig 10] to implement said second bus technology is coupled to said system and to indicate that said second bus technology is available when said external component is coupled to said system [1112, fig 10].

14. In re claim 23, Hwong et al. shows a network adapter [ethernet devices, title].

15. In re claim 24, Hwong et al. shows said controller to implement a medium access control and said component external to said system implements a physical layer [col 7, lines 15-55, fig 10].

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. **Claims 6, 7, 16, 17, 22, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hwong et al., US Patent no. 6,393,500, in view of Chou et al., US Patent no. 7,043,569.**

18. In re claims 6, 7, 16, 17, 22, Hwong et al. does show a mating manger to access, detect, compare and write configuration data [fig 10]. However, Hwong et al. does not show a global unique identifier from said configuration space. Chou et al. shows a global unique identifier for configuration [col 4, lines 9-13]. Therefore, it would have been obvious to the ordinary skilled person in the art at the time the invention was made to include the global unique identifier as shown in Chou et al. for uniquely identifies a device and it's capabilities for faster configuration.

19. In re claim 25, Hwong et al. shows external component is coupled to said system through said bus [fig 12].

20. **Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hwong et al., US Patent no. 6,393,500, as applied to claims 1-9 and 11-19 above.**

21. In re claims 10 and 20, Hwong et al. does not show and utilizing said functions to implement a wireless network capability. Official Notice is taken that both the concept and the advantages of providing for a wireless network capability are old and well known in the art. Therefore, it would have been obvious to the ordinary skilled person in the art at the time the invention was made to include the wireless network capability for user friendly and more flexible device by allowing it to operate in multiple configurations.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

In the remarks, applicants argued in substance that (1) Ethernet and Fast Ethernet are not two different bus technologies. Ethernet has nothing whatsoever to do with buses, (2) Hwong et al. does not show, if the external component is not coupled to said system, indicating the controller is non-functional.

Examiner respectfully traverses applicants' remarks.

As to point (1), by definition, a bus is a common pathway between resources and devices. Hwong et al. clearly shows the resources and devices are connected thru Ethernet and Fast Ethernet. Therefore, Ethernet and Fast Ethernet are two different bus technologies. Applicant may intend to limit the bus as system bus, internal bus, frontside bus, or peripheral bus. However, claimed subject matter, not the specification, is the measure of invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art. In re Self, 213 USPQ 1,5 (CCPA 1982); In re Priest, 199 USPQ 11,15 (CCPA 1978).

As to point (2), Hwong et al. does show if the external component is not coupled to said system, indicating the controller is non-functional [1114, fig 10; 906, 908 in fig 9, save the configuration so that the controller is only functional to the specified ability instead of all supported ability in device configuration, in other words, the controller is non-functional to the technology that the connection is failed as shown in 1114, fig 10].

Conclusion

Applicant's amendment with arguments are not persuasive. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Any response to this action should be mailed to:

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The centralized fax number is 571-273-8300.

The centralized hand carry paper drop off location is:

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Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application should be directed to the central telephone number (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harold Kim whose telephone number is 571-272-4148.

The examiner can normally be reached on Monday-Friday 9AM-5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fritz Fleming can be reached on 571-272-4145. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

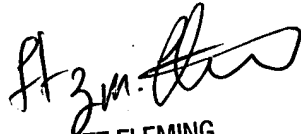
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HK

Harold J. Kim

Patent Examiner

October 15, 2006/HK


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